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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
VFT-014

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on February 7, 2008

Signature

Typed or printed

Name Jocelyn L. Lee

Application Number

10/686,758

Filed

10/15/03

First Named Inventor

George K. Phillips

Art Unit

1794

Examiner

Ferguson, Lawrence D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 42,339

☐ attorney or agent acting under 37 CFR 1.34.

Registration number



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Typed or printed name

949-724-1649

Telephone number

February 7, 2008

Date

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)	Confirmation No.: 8706
George K. Phillips, et al.)	Group Art Unit: 1774
Serial No.: 10/686,758)	Examiner: Ferguson, Lawrence D.
Filed: October 15, 2003)	
For: COPY-RESISTANT SECURITY)	
PAPER)	

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Washington, D.C. 20231

Dear Sir:

Applicant respectfully requests a pre-appeal brief conference. Claims 1, 3, 4, 6, 9-11, 14-20, 22, 23, 25, 28, 29, and 32-49 remain pending in this application. Of these, claims 1, 3, 4, 9-11, 15-20, 22, 23, 28, 29, and 33-37 stand rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,772,248 ("Phillips"), and claims 6, 14, 25, and 32 stand rejected under 35 U.S.C. §103, as being obvious over Phillips.


Under 35 U.S.C. §102, to establish a prima facie case of anticipation of claims 1, 3, 4, 9-11, 15-20, 22, 23, 28, 29, and 33-37, each and every element of these claims must be

CERTIFICATE OF TRANSMISSION

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Jocelyn L. Lee

found in Phillips. Under 35 U.S.C. §103, to establish a prima facie case of obviousness of claims 6, 14, 25, and 32, all of the claim limitations must be taught or suggested by Phillips.

While Applicant disagrees with virtually all of the conclusions set forth by the Examiner in the Advisory Action, dated December 11, 2007, in order to simplify the issues, Applicant will only address in this pre-appeal brief the Examiner's conclusion that the latent image 14 (as the alleged bearer information) is overprinted on the relief image structure 18 and relief background structure 15 (as the alleged reflective layer and image layer).

As stated throughout Phillips, the latent image 14 is optically formed by the contrast between the image structure 18 and relief background structure 15 (see especially col. 4, lines 51-56). In fact, Phillips discusses in great detail the physics behind the optical formation of the latent image 14 by using the contrast between the image structure 18 and relief background structure 15 (see col. 4, line 61 to col. 5, line 38). Despite this clear disclosure, and the fact that nowhere does Phillips disclose that the latent image 14 is ever printed over the image structure 18 and relief background structure 15, the Examiner has concluded otherwise.

In a telephonic interview conducted between the Examiner and Applicant on January 24, 2008, the Examiner pointed to a statement made in Phillips that the image relief pattern 14 is imprinted on the security overlay marker 10 (see col. 3, line 61-62) to support the conclusion that the latent image 14 is printed over the relief image structure 18 and relief background structure 15. However, this statement does not mean that the latent image 14 is printed over the relief image structure 18 and relief background structure 15.

Reading the language "image relief pattern 14" in the context of the entire prior art reference, which the Examiner is required to do, it is clear that this statement means that

the relief structure that forms the latent image 14 (i.e., the relief image structure 18 and the relief background structure 15) is overprinted on the overlay marker 10—not the relief image structure 18 and the relief background structure 15. In fact, Phillips clearly discloses that the latent image 14 is actually created by the relief image structure 18 and the relief background structure 15 (see col. 3, line 67 to col. 4, line 22), and thus, it is the relief image structure 18 and the relief background structure 15 that are overprinted onto the overlay marker 10 to form the latent image 14 (or image relief pattern 14). Therefore, to the extent that the latent image 14 is overprinted on anything, it is overprinted on the bare overlay marker 10, which does not have a relief image structure 18 and relief background structure 15 before the printing of the latent image 14 (and thus, cannot be overprinted onto a relief image structure and relief background structure that does not yet exist).

Because each of independent claims 1, 15, 20, and 33 requires bearer information to be overprinted on or over reflective and diffusive layers, and Phillips does not disclose or suggest this feature, Applicant believes that the Examiner has not established a prima facie case that these independent claims, as well as the claims depending therefrom (claims 3, 4, 6, 9-11, 14, 16-19, 22, 23, 25, 28, 29, 32, and 34-49), are anticipated by, or obvious over, Phillips under 35 U.S.C. §§102, 103.

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Conclusion

For the reasons set forth above, Applicant respectfully submits that the currently pending claims are patentable over the cited prior art, and thus, a notice of allowance is respectfully requested.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: February 7, 2008

By: 

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